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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Etasis Incorporation

Serial No. 75/731,257

Bruce H. Troxell of Dougherty & Troxell for Etasis
Incorporation.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hanak, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Etasis Incorporation (a corporation of the Republic of
China) has filed an application to register on the
Principal Register the mark shown below



for goods amended to read "personal computer[s] (PC) and parts therefor, namely hard disk drives; electrical power supplies for computers, namely switching, swicthable and redundant power supplies." Applicant included the following statement: "The mark has a triangular portion that is lined for the color red." The application was filed on June 17, 1999, based on applicant's claimed dates of first use and first use in commerce which may be regulated by Congress of September 30, 1996 and October 12, 1996, respectively.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark ENTASIS for "computer software design for others"¹; and for "computer game software,"² both registered to the same entity (Entasis, LLC, a California limited liability company), as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

¹ Registration No. 2,146,700, issued March 24, 1998.

² Registration No. 2,162,581, issued June 2, 1998.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

We turn first to a consideration of the cited registrant's goods and services and applicant's goods. Applicant's position is that its goods (personal computers and hard disk drives therefor, and electrical power supplies for computers) involve computer hardware, whereas the registrant's goods and services involve computer software and these goods and services are not similar.

Applicant requested (brief, p. 6) that the Board take judicial notice "of the realities of the computer industry in which it is extremely rare for a single source to manufacture and market both computer hardware and computer software." Applicant's request is denied because this is not the type of fact which may be judicially noticed. See TBMP §712.01.

The Examining Attorney contends that applicant's computer hardware and registrant's computer software and its service of designing computer software for others are all closely related and often emanate from a single source. In support of his position as to the relatedness of the respective goods and services, the Examining Attorney submitted copies of several third-party registrations, all of which issued based on use in commerce, and all of which specifically involve in varying combinations, computer software, computer hardware, power supplies for computers, and designing computer software. He offered these third-party registrations to demonstrate that the same company will provide these goods and services, by showing that a single entity has adopted a single mark for such goods and services.³

While third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them, nonetheless, third-party

³ See, for example, Registration No. 2,398,029 issued for, inter alia, "computer hardware..., computer software..., and electrical power supplies..."; Registration No. 2,362,603 issued for, inter alia, "computer disc drives,... uninterruptible power supplies,... computer software design for others"; Registration No. 2,388,886 issued for, inter alia, "computer hardware,... hard disc drives,...computer operating software..., computer software..."; and Registration No. 1,240,100 issued for, inter alia, "computer hardware..., computer software...."

registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Moreover, it is well settled that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Also, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the

Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, we find that applicant's goods are closely related to registrant's goods and services, as identified. There is a clear commercial relationship between computer hardware (i.e., applicant's personal computers, hard disk drives and electrical power supplies) and computer software (i.e., registrant's computer game software and designing computer software for others) as computer software is the means by which computer hardware operates to organize and process data. See *In re Compagnie Internationale Pour L'Informatique-Cii Honeywell Bull*, 223 USPQ 363 (TTAB 1984); and *In re Graphics Technology Corporation*, 222 USPQ 179 (TTAB 1984).

Applicant argues that purchasers of these goods and services "are sophisticated in nature and would be well informed regarding the items available in the marketplace" (brief, p. 6). However, the argument is not supported by any evidence. Moreover, neither applicant's nor

registrant's respective identifications of goods and services are restricted as to purchasers or trade channels and thus, the Board must consider that the parties' respective goods and services could be offered and sold to the same classes of purchasers--including the general public, through all normal channels of trade. See *Canadian Imperial Bank v. Wells Fargo Bank*, supra; *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Turning then to a consideration of the marks, we agree with the Examining Attorney that they are similar. It is, of course, well settled that marks must be considered in their entirety. However, our primary reviewing Court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Moreover, under actual market conditions, consumers generally do not have the luxury of making side-by-side

comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

In this case, it is obvious that there are some differences in the appearances of the respective marks, as applicant's mark appears in stylized lettering and includes a square design, whereas the registered mark is in typed form. However, we find the dominant source-indicating feature of applicant's mark is the term ETASIS, which is how purchasers or potential purchasers would generally inquire about or request applicant's goods. The non-word portions of applicant's mark do not offer sufficient differences such that the marks as a whole would create separate and different commercial impressions; and the stylistic differences are thus not sufficient to overcome the likelihood of confusion. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With regard to sound, the marks are very similar, ETASIS and ENTASIS, a difference of only one letter different. Applicant's argument regarding different pronunciations of the two marks is not persuasive as there

is no "correct" pronunciation of a trademark. See *In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987); and *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983).

The marks appear to be arbitrary, as there is no evidence regarding the origins or meanings thereof. Thus, potential purchasers have no context or meaning relating to either mark, augmenting the importance of the similarities of sound, appearance and commercial impression.

Overall, we find the marks are similar.

According to applicant, there have been no instances of actual confusion in about five years of coexistence of applicant's mark and the mark in the cited registrations. However, there is no evidence of applicant's and registrant's geographic areas of sales, or the amount of the sales under the respective marks. Further, there is no information from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Finally, any doubt on the question of likelihood of confusion must be resolved against the newcomer as the

newcomer has the opportunity to avoid confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed as to both cited registrations.